

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BART ALAN MELTZER , TERRY ALLEN,
MATTHEW DANIEL FUCHS, ROBERT JOHN GLUSHKO,
and MURRAY MALONEY

Appeal 2006-1639
Application 09/173,858
Technology Center 2100

Decided: May 21, 2007

Before HOWARD B. BLANKENSHIP, ALLEN R. MACDONALD,
and ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

ON REQUEST FOR REHEARING

Appellants request that we reconsider our decision of Aug. 31, 2006, in which we sustained the rejection of claims 1-16 and 61-72 as unpatentable under 35 U.S.C. § 103.

We have reconsidered our Decision of Aug. 31, 2006, in light of Appellants' comment in the request for rehearing, and we find no errors therein. We decline to change our prior Decision for the following reasons:

Appellants argue the Board raises for the first time the issue of the first draft of CBL (Common Business Language) not being submitted with the Rule 131 Declaration filed on Jan. 31, 2005.¹ Appellants argue that if the Examiner had ever raised this as a factual issue, a supplemental declaration could have readily been submitted.

We note that it is Appellants' responsibility to timely submit all evidence necessary to support a Rule 131 declaration. Exhibit A clearly discloses the creation of a first draft of CBL, but Appellants chose not to provide the first draft of CBL with the Rule 131 declaration. The record shows the Examiner, as finder of fact, determined that Appellants' evidence was insufficient to support the Rule 131 declaration (*see* pp. 5-6 of the Office Action mailed on April 18, 2005). We find the prosecution history indicates that Appellants had ample opportunity to provide supplemental declarations as necessary, particularly in view of the fact that the Examiner reopened the prosecution by issuing a non-final office action on April 18, 2005. We found in our Decision that Appellants failed to point to specific portions of Exhibit A to demonstrate actual reduction to practice of specific claim terms (Decision 8, ¶ 2).

In reconsidering the single page of Exhibit A, we again find the listed technical activities 1-6 fail to provide a factual showing that the embodiment relied upon actually worked for its intended purpose (Exhibit A).

Specifically, we find that technical activity 1 merely provides evidence of development of a design *philosophy*. We find that technical activities 2-4 merely disclose *analysis* of: (a) *existing standards*, (b) *proposed* metadata frameworks for Internet resources, and (c) *semantics* of commerce, and *analysis* of certain *proposals* (e.g., “Open Buying on the Internet specification”). We have fully addressed the issue of technical activity 5 *supra* (i.e., creation of a first draft of Common Business Language (CBL)). Lastly, we find that technical activity 6 merely discloses *determining an approach* for CBL support. With respect to the second set of activities (1-5) shown at the bottom of Exhibit A, we note that these activities merely refer to activities *planned* for the second quarter of 1998. We find no evidence of record that these planned activities actually occurred. Thus, we find Appellants have failed to show prior “possession of either the whole invention claimed or something falling within the claim, in the sense that the claim as a whole reads on it.” *See In re Tanczyn*, 347 F.2d 830, 833, 146 USPQ 298, 301 (CCPA 1965). Likewise, we find that Appellants have failed to show “priority with respect to so much of the claimed invention as the reference happens to show.” *See In re Stempel*, 241 F.2d 755, 759-60, 113 USPQ 77, 81 (CCPA 1957).

With respect to the issue of antedating the subject matter of the dependent claims, we note that the plain language of 37 C.F.R. § 1.131(a) is directed to the submission of an appropriate oath or declaration to establish

¹ *See* 37 C.F.R. §1.131.

invention of the subject matter *of the rejected claim*, and not to the claims as a whole (emphasis added), as shown below.

(a) When *any claim* of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter *of the rejected claim* prior to the effective date of the reference or activity on which the rejection is based [emphasis added].

(37 C.F.R. § 1.131(a), revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004).

Even assuming *arguendo* that our reading of the rule is too literal (i.e., given that Appellants are not required to provide an exhibit that supports all the claim limitations),² we nevertheless find the text of Appellants'

² In order to remove a reference, a Rule 131 declaration must show that prior to the effective date of the reference the applicant had reduced to practice so much of the claimed invention as the reference shows. *In re Scheiber*, 587 F.2d 59, 61-62, 199 USPQ 782, 784 (CCPA 1978); *In re Stempel*, 241 F.2d at 759-60, 113 USPQ at 81 (CCPA 1957) ("We are convinced that under the law all the applicant can be required to show is priority with respect to so much of the claimed invention as the reference happens to show. When he has done that he has disposed of the reference."). *cf. In re Tanczyn*, 347 F.2d at 833, 146 USPQ at 301 (CCPA 1965) ("We never intended by the language used in Stempel to authorize the overcoming of references by affidavits showing that the applicant had invented, prior to the reference date, a part, some parts, or even a combination of parts, used to create an embodiment of his claimed invention, where the part or parts are

Declaration fails to make up for the deficiencies of Exhibit A. In particular, we find Appellants have failed to clearly explain how the specific elements of Exhibit A (e.g., the subsumed registry and associated query services) correspond to (or render obvious) specific elements of the instant claimed invention, as enumerated in our Decision on page 8. Likewise, we find Appellants have failed to show a reduction to practice of at least as much of the claimed invention as the McKendrick reference shows. *See In re Stempel*, 241 F.2d at 759-60, 113 USPQ at 81.

In particular, we note that a registry, per se, is not recited in any of instant claims 1-16 or 61-72. We fail to see how a registry (i.e., a place where a register is kept) is equivalent to the recited “interface for transactions” (claim 1). We disagree with Appellants’ sweeping assertion that one of ordinary skill having knowledge of the Declaration (at ¶ 4) and Exhibit A would have understood the registry disclosed in Exhibit A to include interface definition data structures having input and output document schemas (*see* Request for Rehearing, p. 10, § 3). We further note that Appellants correspond the “repository in memory” recited in dependent claim 4 with the “registry” of Exhibit A (*see* Request for Reconsideration, p. 13, note 3). In contrast, we note that a repository in memory more closely corresponds with the “storage units” that are associated with the “interface

not within the scope of the claims being sought ... It is not sufficient to show in a Rule 131 affidavit that an invention wholly outside of that being claimed was made prior to the reference date.”).

for transactions” (claim 1). As pointed out in our Decision at page 12, Appellants made an admission in the Reply Brief:

This reply focuses on the McKendrick reference, because the second WSCI [*sic*, “W3C”] reference serves only to connect XML to the claim wording, “respective descriptions of sets of storage units and logical structures for the sets of storage units.” *Appellants and Respondent agree that this wording reads on XML and XML reads on this wording* [emphasis added]. (Reply Br. 1, ¶ 4).

Thus, we find Appellants have acknowledged that the secondary W3C XML reference teaches “respective descriptions of sets of storage units and logical structures for the sets of storage units,” as claimed (Reply Br. 1, ¶4; claims 1 and 61).

Appellants argue that simply using XML documents does not teach an interface definition data structure that pairs input and output XML documents as a process interface (Request for Rehearing 14).

We note again that McKendrick teaches a web site *interface* for performing “T. Rowe Price” financial transactions as shown in the illustration on page 2 of the reference. Therefore, we find the instant claimed “interface for transactions among nodes in a network” is taught and/or suggested by McKendrick. We note that the Internet includes “a plurality of nodes” and also that web pages are stored on a computer readable medium, as claimed (claim 1). Therefore, we agree with the Examiner that the instant claimed *input* and *output* documents are taught by McKendrick’s use of XML *purchase orders* and *invoices* (see McKendrick, last paragraph on page 2). We note again that a *purchase order* is clearly an *input document* from the perspective of a business providing products or

services to customers over the Internet. We further note that an *invoice* is an *output document* when that same business bills the customer for the provided product or service. Therefore, we find that McKendrick's use of XML (as defined by the W3C XML specification) to perform financial transactions on the Internet clearly meets the language of the claim that recites "a machine readable specification of an interface to transaction processes stored in memory accessible by at least one node in the network, including interpretation information providing a definition of an input document, and a definition of an output document" (claim 1). With respect to Appellants' argument that neither McKendrick nor W3C teaches a "Web services interface," we note that a "Web services Interface" is not claimed (Request for Rehearing 14). Accordingly, for at least the aforementioned reasons, we agree with the Examiner that the combination of McKendrick and W3C teaches and/or suggests all that is claimed.

Pursuant to 37 C.F.R. ¶ 41.52(a)(1), we have no discretion to consider the new evidence and associated new arguments submitted by Appellants with the Request for Rehearing.

Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section. (37 C.F.R. ¶ 41.52(a)(1)).

We note that if Appellants wish to have the newly presented evidence considered by the Examiner, the proper procedure is to file a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114.

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We have carefully considered the arguments raised by Appellants in the Request for Rehearing, but none of these arguments are persuasive that our original Decision was in error. We are still of the view, that the invention set forth in claims 1-16 and 61-72 is unpatentable over the applied prior art based on the record before us in the original appeal. This Decision on Appellants' Request for Rehearing is deemed to incorporate our earlier Decision (mailed Aug. 31, 2006) by reference. *See* 37 C.F.R. § 41.52(a)(1).

We have granted Appellants' request to the extent that we have reconsidered our Decision of Aug. 31, 2006, but we deny the request with respect to making any changes therein.

REHEARING DENIED

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